



OCT 17 2003

INCYTE GENOMICS INC
LEGAL DEPARTMENT
3160 PORTER DRIVE
PALO ALTO CA 94304

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In re Application of :
Y. Tom Tang et al :
Serial No.: 09/831,088 : PETITION DECISION
Filed: May 1, 2001 :
Attorney Docket No.: PF-0622 :

This is in response to applicants' petition filed July 18, 2003, to withdraw an improper *ex parte Quayle* action by the examiner.

BACKGROUND

This application was filed on May 1, 2001, and contained claims 1-20, as filed. The examiner mailed a first Office action to applicants on December 3, 2002, setting forth an eight way restriction requirement. Applicants replied to the restriction requirement by canceling claims 1-20 and presenting claims 21-36. Applicants indicated which claims corresponded to the Groups the examiner had set forth and then elected Group II to a polynucleotide and traversed the requirement with respect to Groups I and III, IV and VII for various reasons. Groups V, VI and VIII were canceled. Rejoinder of Groups II and II was specifically requested in view of *In re Ochiai*.

The examiner mailed a second Office action to applicants as an *ex parte Quayle* action on April 21, 2003. The Office action indicated claims 24-26 and 31 as allowable and requested applicants to cancel the non-elected claims. An interview summary record accompanied the Office action indicating that the examiner had contacted applicants concerning such cancellation, but that applicants were of the opinion that claims 32-34 should be rejoined with the allowed product claims.

Applicants replied to the Office action on June 19, 2003, by filing this petition and also filing an amendment on June 23, 2003. The petition requests that the *ex parte Quayle* action be vacated and the method of use claims be rejoined with the product claims under *In re Ochiai*.

DISCUSSION

37 CFR 1.181 provides an applicant the ability to request review of an examiner's action if the action is thought to be improper. It also requires that the action be a repeated action. In other words, the examiner has to take an action, have reconsideration of that action be requested by applicant and then maintain or repeat the action.

In the above background it is noted that the action complained of is the issuance of an improper *ex parte Quayle* action refusing rejoinder of method claims with allowable product claims. Since this is the first time the action has been taken, review of the action is not proper at this time.

DECISION

The petition is DISMISSED as MOOT in view of the discussion above.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

No petition fee is required for this petition and the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 09-0108, as directed.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.



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